

REMARKS/ARGUMENTS

Favorable reconsideration of this application in light of the following discussion, is respectfully requested.

Claims 1-38 are pending in this application. Claims 1-38 have been amended to better clarify the present invention in a manner better conforming to accepted U.S claim practice without introducing any new matter.

The outstanding Office Action presents a rejection of Claims 1, 17, 18, and 34 as being anticipated by Coiera (U.S. Patent No. 5,572,636), a rejection of Claims 2-11 and 19-28 as being unpatentable over Coiera in view of Xu et al. (U.S. Patent No. 6,151,628, Xu) under 35 U.S.C. § 103(a), a rejection of Claims 12, 13, 15, 16, 29, 30, 32, and 33 as being unpatentable over Coiera in view of Xu in further view of White et al. (U.S. Patent No. 6,014,379, White) under 35 U.S.C. § 103(a), and a rejection of Claims 14 and 31 as being unpatentable over Coiera in view of Xu in further view of Dussell et al. (U.S. Patent No. 5,938,721, Dussell) under 35 U.S.C. § 103(a).

Applicants acknowledge with appreciation the allowance of Claims 35-38.

Before considering the outstanding prior art based rejections, Applicants believe that a brief review of the present invention would be helpful. In this respect the present invention includes a communication system and corresponding method adapted to enable a telephone/Internet connection between a mobile subscriber station of a cellular radio communication network and a specified Internet user the mobile subscriber station is seeking to be connected to. The cellular radio communication network includes a short message service (SMS) and the communication system includes a telephony/Internet server adapted to facilitate establishment of the desired telephony/Internet connection. In operation, the SMS transfers inquiry information from the mobile subscriber station to the telephony/Internet serve that identifies the

Internet address for the specified Internet user that the mobile subscriber station would like to place a telephone call to. The telephony/Internet server then replies to receipt of this inquiry information by sending return information via SMS to the mobile subscriber station which, at a minimum, specifies if the telephony/Internet connection sought by the mobile subscriber station is possible.

Turning to the rejection of Claims 1, 17, 18, and 34 as being anticipated by Coiera, it is clear that this rejection cannot be maintained as there is no teaching or suggestion to be found anywhere in Coiera of any telephony/Internet server that replies to receipt of an inquiry from a mobile subscriber station that identifies an Internet address for a specific Internet user that the mobile subscriber station would like to place a telephone call to, much less one that sends the claimed return information via SMS to the mobile subscriber station specifying if the telephony/Internet connection sought by the mobile subscriber station is possible.

As base independent system Claim 1 and base independent method Claim 18 recite the mobile station provides the internet address for the specified internet user that contact is desired with and that the server must supply return information that must at least indicate if the desired connection is possible, the rejection thereof as being anticipated by Coiera is traversed.

Moreover, as Claim 17 depends from Claim 1 and Claim 34 depends from Claim 18, the rejection thereof as being anticipated by Coiera is traversed for the reasons noted above as to the respective parent claim.

With respect to the rejection of Claims 2-11 and 19-28 as being unpatentable over Coiera in view of Xu, it is first noted that Xu does not correct the above-noted deficiencies of Coiera. Accordingly, even if actual and reasonable motivation had been established to combine the teachings of these disparate references, which is not

the case, the result would still not include all the subject matter of base independent Claims 1 or 18. Therefore, as Claims 2-11 all ultimately depend on Claim 1 and include all the limitations thereof, and Claims 19-28 all ultimately depend on Claim 18 and include all the limitations thereof, their rejection as being unpatentable over Coiera in view of Xu is traversed.

With further regard as to motivation, it is noted that Coiera is only concerned with storing role identifiers (for doctors in particular) so that general inquiries for the "on call" person (doctor) filling one of these roles can be made by the server with no further contribution by the user (nurse) placing the inquiry other than the identification of one of the roles. Thus, the server attempts to contact the first person listed as filling the role at various locations using contact numbers left by that person, not any Internet address supplied information left by the user seeking any person "on call" filling the role of concern. Accordingly, the input from the mobile stations cannot be said to identify any Internet address for any specific Internet user. Furthermore, if an internet address is present at all, it may not be the first contact attempted (see col. 6, lines 5- 11) so that the person may well be contacted by regular telephone, for example, before any Internet contact is attempted.

Furthermore, there would be no reason for the server of Coiera to send any message to the user (nurse) as to the lack of an ability to reach any particular "on call" person (doctor) by an Internet connection. In this respect, when any person listed in an "on call" role does not respond, the next on the list is contacted. See col. 5, line 49- 15. Moreover, the only suggested use of the Internet by the user (nurse) seeking the person filling the role (doctor) is that the user will establish standard E mail contact as noted at col. 6, lines 26-29, not telephone contact via the Internet.

In complete contrast to the Coiera system of contacting “on call” individuals, Xu is concerned with connecting a source of digital data to a computer network. What is lacking from the outstanding rejection is the required demonstration of some reason why the artisan would even select these disparate references for combination, much less select isolated and unrelated teachings from each as suggested in the outstanding Action. See In re Rouffet, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) (“In other words, the [PTO] must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.”). As further noted in Rouffet, at 47 USPQ2d 1458, the PTO reviewing court requires that “the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” This has not been done and this rejection of Claims 2-11 and 19-28 as being unpatentable over Coiera in view of Xu, is traversed for this reason as well.

Turning to the rejection of Claims 12, 13, 15, 16, 29, 30, 32, and 33 as being unpatentable over Coiera in view of Xu in further view of White, it is first noted that White does not correct the above-noted deficiencies of Coiera and/or Xu. Accordingly, even if actual and reasonable motivation had been established to combine the teachings of these three disparate references, which is not the case, the result would still not include all the subject matter of base independent Claims 1 or 18. Therefore, as Claims 12, 13, 15, and 16 all ultimately depend on Claim 1 and include all the limitations thereof, and Claims 29, 30, 32, and 33 all ultimately depend on Claim 18 and include all the limitations thereof, their rejection as being unpatentable over Coiera in view of Xu in further view of White is traversed.

Furthermore, no reasonable motivation has been established to combine Coiera, Xu, and White. In complete contrast to the Coiera system of contacting on call personnel and the Xu concern with connecting a source of digital data to a computer network, White is concerned with call forwarding. What is once again lacking from the outstanding rejection is the required demonstration of some reason why the artisan would even select these three references for combination, much less select isolated and unrelated teachings from each as suggested in the outstanding Action. Once again there has been no showing of reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements noted in the rejection from the three cited prior art references for combination in the manner claimed. Accordingly, this rejection of Claims 12, 13, 15, 16, 29, 30, 32, and 33 as being unpatentable over Coiera in view of Xu in further view of White is traversed for this reason as well.

As to the rejection of Claims 14 and 31 as being unpatentable over Coiera in view of Xu in further view of Dussell, it is once again noted that the newly relied upon reference (Dussell) does not correct the above-noted deficiencies of Coiera and/or Xu. Accordingly, even if actual and reasonable motivation had been established to combine the teachings of these three disparate references, which is not the case, the result would still not include all the subject matter of base independent Claims 1 or 18. Therefore, as Claim 14 ultimately depends on Claim 1 and includes all the limitations thereof, and Claim 31 ultimately depends on Claim 18 and includes all the limitations thereof, their rejection as being unpatentable over Coiera in view of Xu in further view of Dussell is traversed.

In addition, this outstanding rejection also lacks the required demonstration of some reason why the artisan would even select these three disparate references for

combination, much less select the isolated and unrelated teachings from these three disparate references as suggested in the outstanding Action.

The differences between Coiera and Xu have been noted above. In contrast to these references, Dussell is concerned with a position based task performance system with no apparent relevance to Coiera and Xu. Therefore, and as noted above, there has been no showing of reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the isolated and unrelated elements relied on in the outstanding Action.

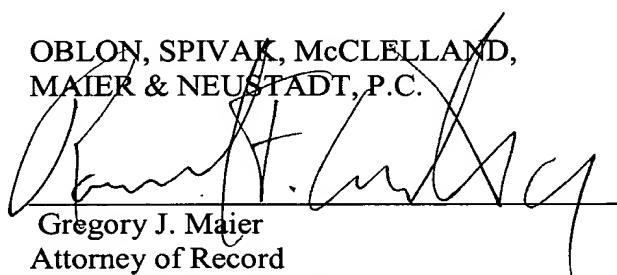
Consequently, this rejection of Claims 14 and 31 as being unpatentable over Coiera in view of Xu in further view of Dussell is traversed for this reason as well.

CONCLUSION

In view of the foregoing amendment and remarks, it is respectfully submitted that no further issues remain outstanding in the present application, and that this application is clearly in condition for formal allowance and an early and favorable action to that effect is, therefore, respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Gregory J. Maier
Attorney of Record
Registration No. 25,599
Raymond F. Cardillo, Jr.
Registration No. 40,440

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/03)